



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,229	03/30/2004	Michael Frederick Kenrich	2222.5490000	8114
26111 7590 10/05/2009 STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
EXAMINER				
ABEDIN, SHANTO				
ART UNIT		PAPER NUMBER		
2436				
MAIL DATE		DELIVERY MODE		
10/05/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/815,229

Applicant(s)

KENRICH ET AL

Examiner

SHANTO M. ABEDIN

Art Unit

2436

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/02/2009 has been entered.
2. Claims 1-4 and 6-26 have been presented for examination.
3. Claims 1-4 and 6-26 have been rejected.
4. The examiner notes, upon further examination, new grounds of 35 USC 101 type rejections are found and presented in this office action.

Response to Arguments

5. The applicant's arguments regarding obviousness type double patenting rejections are fully considered, however, upon further examination, new grounds for obviousness type double patenting rejections are found, and presented in this office action.
6. The applicant's arguments regarding 35 USC 112 first paragraph type rejections are fully considered. The previous 35 USC 112 first paragraph type rejections are withdrawn because of the amendments made to the claims.
7. The applicant's arguments regarding 35 USC 102 (e) type rejections are fully considered, and found persuasive. The previous 35 USC 102(c) type rejections of claims 1-4 and 6-26 are withdrawn. However, upon further search and examination, new grounds for 35 USC 102(e) and 103(a) type rejections for claims 1, 6-14 and 21 are found, and presented in this office action.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claim 25 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claim 25, it is directed to a computer-implemented file security system for restricting access to an electrical file. However, although the preamble of the claim recites a computer, the actual claim limitations fail to disclose explicitly any non-software, or computer structure/ hardware type component as a part of such security system. In particular, the claimed system incorporates modules for storing, and access control management, however, according to the specification (Par 019 and 101; submitted on 03/30/2004), such system or modules could optionally be implemented in software only. A reasonable interpretation of the claimed system is just a collection of components or modules which could just be software elements and not include hardware. Therefore, claimed invention is considered to be non-statutory for lacking any hardware, or computer structure as a part of it. See MPEP 2106.01.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application

Art Unit: 2436

or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-4 and 6-26 are provisionally rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1-3 and 9-38 of copending application no. 10/815251 in view of Shapiro et al (US 2005/0097061 A1)

In particular, claims 1-4, 6-12 and 21-24 of the instant application are unpatentable over claims 1-3, 9-11 and 29-37 of the copending application 10/815251. Similarly, claims 13-20 and 25-26 are unpatentable over claims 1-3, 9-28 and 33-36 of the copending application 10/815251.

Although the conflicting claims are not identical, they are not patentably distinct from each other because all the claimed elements/features of the instant application exist in claim-set of the copending application in similar or different names, essentially performing same tasks.

Differences between the conflicting claims of the instant application and the conflicting claims of the copending application are that the conflicting claim set of the instant application are recited over the one or more claims of the copending application. Furthermore, while copending application claim set recites "retention policy" as specifying data retention period based on future scheduled event, the instant application recites the "retention policy" in terms of retention schedule. Conflicting claim set of the copending application fails to disclose though cut off period for the electronic document access further associated with the maximum off-line period.

However, at the time of invention, it would have been obvious to a person of ordinary skill in the art to design a method/ system wherein features are described differently in order to provide an alternative embodiment for the claimed invention. Furthermore, Shapiro et al discloses cut off period for the electronic document access further associated with the maximum off-line period (Par

008, 020 and 117; document access permission/ rejection based on offline access information.)
Shapiro et al and the copending application are from the same field of endeavor of secure access of the electronic documents. Therefore, at the time of invention, it would have been further obvious to a person of ordinary skill in art to combine the teaching of Shapiro et al with the conflicting claim set of the copending application to design a method/system to further include the features wherein cut off period for the electronic document access further associated with the maximum off-line period in order to provide an alternative control mechanism for offline document access.

This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

10. Claims 1-4 and 6-26 are provisionally rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1-31 of copending application no. 10/676850 in view of Shapiro et al (US 2005/0097061 A1.)

Although the conflicting claims are not identical, they are not patentably distinct from each other because all the claimed elements/features of the instant application exist in claim-set of the copending application in similar or different names, essentially performing same tasks.

Differences between the conflicting claims of the instant application and the conflicting claims of the copending application are that the conflicting claim set of the instant application are recited over the one or more claims of the copending application. Furthermore, while conflicting claims of the copending application claim set recite "access restrictions", or "access rules", the instant application claim set recites such restrictions as part of retention policies. Furthermore, conflicting claim set of the copending application recites broader term such as "time-based access key" instead of the narrower terms such as "keys associated with particular cut-off period" or "keys

Art Unit: 2436

.. corresponding maximum off-line periods.” Conflicting claim set of the copending application fails to disclose though cut off period for the electronic document access further associated with the maximum off-line period.

However, at the time of invention, it would have been obvious to a person of ordinary skill in the art to design a method/ system wherein features are described differently or more specifically in order to provide an alternative embodiment for the claimed invention. Furthermore, Shapiro et al discloses cut off period for the electronic document access further associated with the maximum off-line period (Par 008, 020 and 117; document access permission/rejection based on offline access information.) Shapiro et al and the copending application are from the same field of endeavor of secure access of the electronic documents. Therefore, at the time of invention, it would have been further obvious to a person of ordinary skill in art to combine the teaching of Shapiro et al with the conflicting claim set of the copending application to design a method/system to further include the features wherein cut off period for the electronic document access further associated with the maximum off-line period in order to provide an alternative control mechanism for offline document access.

This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international

application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1, 6-9 and 21 are rejected under 35 USC 102 (c) as being anticipated by Shapiro et al (US 2005/0097061 A1)

Regarding claims 1 and 21, Shapiro et al discloses a method/ medium of providing automated document retention for an electronic document comprising:

assigning a document retention policy to the electronic document (Par 007-008, 083; policies/rules, or permissions associated with the document) , the document retention policy being derived from a recurring cut-off retention schedule specifying cut-off periods (Par 020, 086, 117; specific access time) each cut-off period having a respective document retention duration associated therewith and corresponding to a respective maximum off-line period of a client, wherein the maximum off-line period expires a predetermined period of time after a beginning of its cut-off period (Par 020, 117; offline access period) and

encrypting the electronic document based on the document retention policy such that the electronic document can be cryptographically accessed only during retention durations and prior to the expiration of the maximum off-line period of the client (Par 011-012, 020, 086-087; access to the encrypted document dependent on off-line/ access time.)

Regarding claim 6, Shapiro et al discloses the method wherein said encrypting comprises acquiring a cryptographic key from a server over a network, the cryptographic key being used to encrypt the electronic document based on the document retention policy (Par 008-010, 20; sever employing keys for accessing document according to policy.)

Regarding claim 7, Shapiro et al discloses the method further comprising: deactivating the cryptographic key when the respective document retention duration has expired, thereby preventing further access to the electronic document (Par 012, 120, 123, 129-130; invalidating/ expiring key after specific offline/ access period.)

Regarding claim 8, Shapiro et al discloses the method wherein: said encrypting uses a cryptographic key to encrypt the electronic document based on the document retention policy (Par 008-010, 20; employing keys for accessing document according to policy), and the document retention policy specifies respective document retention durations and cut-off periods (Par 012, 120, 123, 129; invalidating/ expiring key after specific offline/ access period.)

Regarding claim 9, Shapiro et al discloses the method wherein the document retention policy specifies the respective document retention duration that expires a predetermined period of time after a beginning of its respective cut-off period (Par 020, 086, 117; specific access time)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 10-14 are rejected under 35 USC 103 (a) as being unpatentable over Shapiro et al (US 2005/0097061 A1) in view of Batten-Carew et al (US 6603857 B1)

Regarding claim 10, Shapiro et al discloses a method of limiting access to an electronic document comprising:

determining whether a period for a first document retention key has elapsed (Par 012, 123, 129-130; specific encryption/ session key associated with the each document access period.)

generating a next document retention key to be used to encrypt the electronic document during a next period (Par 010-012, 086-087, 123; encrypted document with the generated key associated with the offline/ access period), the next document retention key having a document retention duration associated therewith and corresponding to a maximum off- line period of a client, wherein the maximum off-line period expires a predetermined period of time after a beginning of the next period (Par 012, 086, 120, 123, 129-130; validity of the encryption/ session key is associated with the specific offline/access period); and

notifying the client of the next document retention key, the electronic document being cryptographically accessible only during document retention durations and prior to the expiration of the maximum off-line period of the client using a cryptographic key associated with such durations (Par 086, 120, 123, 129-133; expiration of the offline/ access time, and associated specific/ valid key.)

Although Shapiro et al teaches bounded time for offline document access (Par 020, 086), and specific key for accessing the document in an offline session, or expiring validity of such key (Par 012, 120, 123, 129-130), it fails to teach expressly associating the first and the next retention keys with the specific cut-off periods.

However, at the time of invention, use of each specific key with a specific cut-off period would be obvious from the above teachings of Shapiro et al. Alternatively, if the position of inherency/ obviousness is not found to be supportable, the examiner holds the position that it

Art Unit: 2436

would have been obvious to a person with ordinary skill in the art to modify Shapiro et al's teachings by combining/ substituting with the features of utilizing a cut-off period for a first document retention key, and a next cut-off period for the next document retention key taught by Batten-Carew et al (Col 6, starts at line 16; time sensitive keys only valid for specific future time.)

Batten-Carew et al and Shapiro et al are analogous art because they are from the same field of endeavor of securing information. Therefore, at the time of invention, it would have been obvious to a person with ordinary skill in the art to alternatively combine/ substitute the teaching of Batten-Carew et al with Shapiro et al to design a method further comprising the features of associating the first and the next retention keys with the specific cut-off periods in order to provide an alternative time based document access mechanism.

Regarding claim 13, it is rejected applying as same motivation and rationale applied above rejecting claim 10, furthermore, Shapiro et al discloses a method for restricting access to an electrical document, said method comprising:

encrypting a data portion of the electronic document using a document key to produce an encrypted data portion (Par 008, 010, 086; encrypting at least portion of the document/ information with the encryption key)

using a retention access key to associate a document retention policy with the electronic document (Par 007-008,020, 083, 120; policies/rules, or permissions associated with the document access key);

encrypting the document key using the retention access key to produce an encrypted document key (Par 010-012, 086-087, 123; encrypting document with the generated key associated with the offline/ access period), the retention access key being usable for said encrypting during a

period of a recurring cut-off retention schedule, the period having a document retention duration associated therewith and corresponding to a maximum off-line period of a client, wherein the maximum off-line period expired a predetermined period of time after a beginning of the period (Par 012, 086, 120, 123, 129-130; validity of the encryption/ session key is associated with the specific offline/access period);

forming a secured electronic document from at least the encrypted data portion and the encrypted document key (Par 008-012, 020; encrypted document, and key); and

storing the secured electronic document, the secured electronic document being cryptographically accessible only during the document retention duration and prior to the expiration of the maximum off-line period of the client (Par 008, 020, 086, 120, 123, 129; storing encrypted document in client side for accessing during the specific or valid offline/access period and key);.

Although Shapiro et al teaches bounded time for offline document access (Par 020, 086), and specific key for accessing the document in an offline session, or expiring validity of such key (Par 012, 120, 123, 129-130), it fails to teach expressly associating the first and the next retention keys with the specific cut-off periods.

However, at the time of invention, use of each specific key with a specific cut-off period would be obvious from the above teachings of Shapiro et al. Alternatively, if the position of inherency/ obviousness is not found to be supportable, the examiner holds the position that it would have been obvious to a person with ordinary skill in the art to modify Shapiro et al's teachings by combining/ substituting with the features of utilizing a cut-off period for a first document retention key, and a next cut-off period for the next document retention key taught by Batten-Carew et al (Col 6, starts at line 16; time sensitive keys only valid for specific future time.)

Regarding claim 11, Shapiro et al discloses the method further comprising deactivating a cryptographic key according to a predetermined schedule (Par 086, 120, 123, 129-133; expiration of the offline/ access time, and associated specific/ valid key.)

Regarding claim 12, Shapiro et al discloses the method wherein the document retention duration is a predetermined duration of time following a beginning of the next cut-off period (Par 020, 086, 117, 120; specific/ bounded document access time)

Regarding claim 14, Shapiro et al discloses the method wherein the retention access key is a public retention access key (Par 011-012; public key.)

Allowable Subject Matter

13. Claims 2-4, 15, 17-20, 22-24 and 26 would be allowable if rewritten or by filing a terminal disclaimer to overcome the obviousness type double patenting rejection(s), set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
14. Claim 25 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101, set forth in this Office action.
15. Claim 16 would be allowable if rewritten or by filing a terminal disclaimer to overcome the obviousness type double patenting rejection(s), set forth in this Office action.

Conclusion

16. Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be

Art Unit: 2436

applied as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

17. A shortened statutory period for response to this action is set to expire in 3 (Three) months and 0 (Zero) days from the mailing date of this letter. Failure to respond within the period for response will result in ABANDONMENT of the application (see 35 U.S.C 133, M.P.E.P 710.02(b)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shanto M Z Abedin whose telephone number is 571-272-3551. The examiner can normally be reached on M-F from 10:00 AM to 6:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Moazzami Nasser, can be reached on 571-272-4195. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. The RightFax number for faxing directly to the examiner is 571-273-3551.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shanto M Z Abedin

Examiner, AU 2436

/Nasser G Moazzami/

Supervisory Patent Examiner, Art Unit 2436